

Appl. No. : 09/277,482
Filed : March 26, 1999

REMARKS

In response to the Office Action, Applicant respectfully requests the Examiner to reconsider the above-captioned application in view of the foregoing amendments and the following comments.

Discussion of Claim Rejections Under 35 U.S.C. §§ 102(b) and 103(a)

In the Office Action, the Examiner rejected Claims 1, 2, 4-12, 18 and 19 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,864,616, to Pond (hereinafter "Pond") in view of Microsoft Press Computer Dictionary (hereinafter "MPCD"). Claims 13-15, 21, and 22 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Pond. Claims 16 and 17 were rejected under 35 U.S.C. § 102(b) as being anticipated by Pond. To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *See M.P.E.P. § 2143.03.* Furthermore, Applicant respectfully submits that a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference. *See M.P.E.P. § 2131.* Applicant respectfully submits that Pond and MPCD fail to teach or suggest at least one claim limitation from each of the above-listed claims, as amended.

In one embodiment of the invention, a logic circuit is configured to receive digital data from a host processor. The logic circuit forwards the digital data to a digital data storage device in an encrypted form. In one embodiment, the logic circuit is configured to encrypt said digital data and forward the digital data to the digital storage device without intervention of the host processor. For example, Figure 3 illustrated in one embodiment that a logic circuit (50) is between a processor (36) and drives (38) and (40). The logic circuit (50) receives data provided by the processor (36) and encrypts the data prior to transmission to the hard drives (38) and (40). In one embodiment, the logic circuit (50) is part of a bus-to-bus bridge. *See page 9, lines 9 – 23.* The bus-to-bus bridge includes a configuration that is used to store information that is used by the bus-to-bus bridge to determine when to enable and disable encryption. The configuration register may store bits that are used to determine which storage devices are to receive encrypted data.

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Turning to the claims it is seen that Claim 1, as amended, recites "wherein said bus-to-bus bridge is configured to encrypt said digital data and forward the digital data to the digital storage device without intervention of the host processor, and wherein a configuration register in the bus-to-bus bridge is adapted to store information that is used by the bus-to-bus bridge to selectively enable and disable encryption depending on the target device that is to receive the data that is transmitted via the bus-to-bus bridge." Independent Claims 7, 11, 13, and 17 each recite similar limitations.

Applicant respectfully submits that there is no teaching or suggestion in Pond that the security system is included in a bus-to-bus bridge. Pond is directed to a method of cryptographically labeling electronic stored data that is stored in a personal computer. See col. 2, line 61-64. In Pond, the security system is installed in an expansion slot of the personal computer. Applicant respectfully submits that in Pond, the security system included in a bus-to-bus bridge, as is claimed. In the Office Action, with respect to Claims 18 and 19 (now cancelled); the Examiner took the position that one of ordinary skill in the art would have been motivated to use the security system of Pond in a bus-to-bus bridge. The Examiner stated this would "delay transaction processes I/O read/write, configuration read/write and memory transactions." Applicant respectfully fails to comprehend how this delay is beneficial or is suggested by the cited references. Furthermore, the Examiner stated that this reduces the error rate. Again, Applicant respectfully fails to comprehend how this would minimize the error rate.

Applicant submits that these findings do not support a valid *prima facie* rejection. Applicant submits that the prior art must suggest the desirability of the claimed invention. *See* M.P.E.P. § 2143.01. The fact that references can be modified is not sufficient to establish *prima facie* obviousness. *Id.* Furthermore, the fact that the claimed invention is within the capability of one of ordinary skill in the art is not sufficient by itself to establish *prima facie* obviousness. *Id.* In this case, the Examiner has merely made conclusory findings regarding the motivation to modify the Pond system. Furthermore, the benefits cited by the Examiner for such combination do not seem to be suggested by the references themselves or otherwise.

Moreover, Applicant respectfully submits that Pond fails to teach or suggest "wherein a configuration register in the bus-to-bus bridge is adapted to store information that is used by the logic circuit to selectively enable and disable encryption depending on the target device that is to

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receive the data that is transmitted via the bus-to-bus bridge." Applicant respectfully submits that this limitation is also wholly missing from the cited prior art.

Moreover, Applicant respectfully submits that there is no teaching or suggestion in Pond that the security system is configured to encrypt data and forward the data to a storage device without intervention of the host processor. Pond is directed to a method of cryptographically labeling electronic stored data that is stored in a personal computer. See col. 2, line 61-64. In Pond, the security system is installed in an expansion slot of the personal computer. Applicant respectfully submits that in Pond, the security system is not a direct intermediary between the disk drives and the processor, as is claimed.

Furthermore, Applicant respectfully submits that these limitations are not taught or suggest by MPCD. MPCD was merely used in the Office Action in support of the fact that the use ROMs are known in the computing industry. Since the cited references fail to teach or suggest at least these limitations, Applicant respectfully submits that this case is in condition for allowance.

Summary

Applicant has endeavored to address all of the Examiner's concerns as expressed in the outstanding Office Action. Accordingly, amendments to the claims for patentability purposes, the reasons therefore, and arguments in support of the patentability of the pending claim set are presented above. Any claim amendments which are not specifically discussed in the above remarks are not made for patentability purposes, and the claims would satisfy the statutory requirements for patentability without the entry of such amendments. In addition, such amendments do not narrow the scope of the claims. Rather, these amendments have only been made to increase claim readability, to improve grammar, and to reduce the time and effort required of those in the art to clearly understand the scope of the claim language. In light of the above amendments and remarks, reconsideration and withdrawal of the outstanding rejections is

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specifically requested. If the Examiner has any questions which may be answered by telephone, he is invited to call the undersigned directly.

Respectfully submitted,

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